

REMARKS

At the time of the Office Action dated June 6, 2006, claims 1-13 were pending and rejected in this application. Claims 11-13 have been cancelled. Applicants acknowledge, with appreciation, the Examiner's indication that claims 5-6 and 8 contain allowable subject matter.

THE REJECTION OF CLAIMS 1-9 AND 11-13 AND UNDER 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-9 and 11-13 is directed to non-statutory subject matter. This rejection is respectfully traversed.

In the Amendment filed March 8, 2006, Applicants previously argued that the Examiner had cited any case law that supports the Examiner's conclusion that a method must be "tangibly embodied." The Examiner's response to this argument is found on page 8 of the Office Action in which the Examiner concluded that "[t]he combination of the method and a computer readable medium would render this a substantial practical application and therefore compliant under 35 U.S.C. § 101.

There is **no requirement** that a method, which can be performed by a computer, must be claimed as part of a computer readable medium. The U.S. Patent Office has already issued thousands, if not tens of thousands of patents, which include similar types of claims since the

Federal Circuit decision of State Street Bank & Trust Co. V. Signature Financial Group, Inc.¹

Although issued prior the State Street Bank decision, the Examiner is referred to U.S. Patent No. 5,333,184 (hereinafter the '184 patent). Claim 1 of the '184 patent is reproduced below:

1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

Upon reviewing this claim, it is readily apparent to a layman in the art that all of the method steps recited in this claim could be performed by a computer. Thus, if the Examiner's analysis on page 8 of the present Office Action was followed at the time the application, which matured into the '184 patent, was examined, then this claim would have been rejected under 35 U.S.C. § 101.

Applicants have referred to the '184 patent because this patent was the subject of the decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.² The conclusion of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is properly within the statutory scope of 101." Thus, the Examiner's implied assertion that an invention capable of being implemented in software alone is per se not directed to statutory subject matter directly contradicts the decision by the Federal Circuit that the claimed subject

¹ 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1999).

² 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

matter recited in the '184 patent is directed to statutory subject matter. Moreover, the Examiner has failed distinguish between the present claims and the claims of the '184 patent so as to support a finding that the present claims are not directed to statutory subject matter.

Applicants are unaware of any case law that has overturned AT&T Corp. In fact, the Examiner is also directed to the first page of the latest version of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility"³ issued on November 22, 2005 (hereinafter "Interim Guidelines"). Specifically, Applicants note that the Federal Circuit decision of AT&T Corp. is mentioned side-by-side with the State Street Bank decision. Therefore, it is readily apparent that the Federal Circuit decision of AT&T Corp. is still good law, which must be followed by the Examiner.

Applicants note that the Examiner cited the decision of In re Warmerdam⁴ and In re Lowry⁵ on page 8 of the Office Action. However, neither of these decisions support the Examiner's analysis. As noted by the Federal Circuit in the AT&T Corp. decision, the process claims at issue in In re Warmerdam "did nothing more than manipulate basic mathematical constructs" and the court's decision was founded on the basis that "taking several ideas and manipulating them together adds nothing to the basic equation." The claim to a data structure found to be nonstatutory subject matter in In re Warmerdam did not just involve the manipulation of a data structure. Instead, the claim was to a data structure, per se. Specifically claim 6 recited "[a] data structure generated by the method of any of Claims 1 through 4." Since the Applicants present invention neither manipulates "basic mathematical constructions" nor

³ Official Gazette Notices, November 22, 2005.

⁴ 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994).

⁵ 33 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

claims a data structure, per se, then Applicants respectfully submit that the Examiner has inappropriately relied upon In re Warmerdam to support the Examiner's analysis.

The Examiner's citation of In re Lowrey is also inappropriate. In this decision, while discussing the prior proceedings before within the U.S. Patent Office, the Federal Circuit noted that "[t]he Board reversed the 35 U.S.C. Section 101 rejection" since the claims, which were "directed to a memory containing stored information, as a whole, recited an article of manufacture." Despite referring to this rejection, the Federal Circuit did not address the issue of statutory subject matter under 35 U.S.C. § 101. As such, the Board's reversal of the Examiner's rejection of the claims under 35 U.S.C. § 101 was left standing. However, the Federal Circuit addressed the concept of a data structure within a memory with regard to an obviousness rejection and held the following:

In short, Lowrey's data structures are physical entities that provide increased efficiency in computer operation. They are not analogous to printed matter. The Board is not at liberty to ignore such limitations.

As noted above, Applicants present invention is not directed to a data structure, per se. Therefore, Applicants submit that the Examiner has inappropriately relied upon In re Lowrey to support the Examiner's analysis.

Thus, for the reasons stated above, Applicants respectfully submit that the Examiner has failed to properly establish that the claimed invention, as recited in claims 1-9 is directed to non-statutory subject matter. Moreover, the Examiner has failed to follow the case law established by the Federal Circuit in the AT&T Corp. decision. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-9 under 35 U.S.C. § 101.

**CLAIMS 1-4, 7, AND 9-13 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON BY DURHAM, U.S. PATENT NO. 7,032,183, IN VIEW OF ALEXANDER ET AL., U.S.
PATENT NO. 5,986,654**

On pages 3-7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Durham in view of Alexander to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 1

Independent claim 1 recites, in part, the following limitations:

responsive to a selection of one of said menu-item description and said graphical icon, further distributing over said network to said content browser a graphical menu-structure encoded in at least one additional form-submit element.

To teach the limitation, the Examiner relied upon column 9, lines 49-67 of Durham, which for ease of reference is reproduced below:

The routine 1000 begins at block 1002, where a determination is made as to whether data associated with the selected section of the menu is contained in the data object 314. If it is determined that there is no data in the data object 314 corresponding to the selected portion of the menu, there is no menu to display. Accordingly, the routine 1000 branches from block 1002 to block 1022, where it ends. If, however, data is contained in the data object 314 associated with the selected portion of the menu, the routine 1000 continues to block 1004.

At block 1004, a determination is made as to whether a level of the cascading menu is currently being displayed other than the selected level. If another level of the menu is currently being displayed, the routine 1000 continues to block 1006, where the currently displayed level of the menu is removed. The routine 1000 then continues to block 1008. If, at block 1004, it is determined that no other level of the menu is currently being displayed, the routine 1000 branches from block 1004 to block 1008.

Upon reviewing these passages, Applicants note that Durham fails to teach or suggest the above-identified limitations recited in claim 1.

Referring to Fig. 10, Durham teaches that if no data is in the data object 314, which corresponds to the menu, then the routine 1000 ends at block 1022 and no menu is displayed. However, if data is present in the data object 314, "the appropriate string for building the selected portion of the cascading menu is retrieved from the data object 314 (column 10, lines 1-3). This string from the data object 314 is used to generate each level of the cascading menu (column 10, lines 3-5). At block 1010, the selected portion of the cascading menu is built using the string (column 10, lines 10-12).

Referring to Fig. 8 and column 9, lines 3-10, Durham teaches the following:

The Web page 300 also includes a datafile code script tag 306. This tag causes the browser to download the datafile code 312. The datafile code 312 is an executable script for building a data object 314 in memory comprising the titles of the Web site's Web pages and links to the titled Web pages. The datafile code 312 will be described in greater detail below with respect to FIG. 9. It should be appreciated that while the site browser code 310 and the datafile code 312 are shown as being external to the Web page 300, these scripts may be placed in-line within the HTML 302. However, by placing these files external to the Web page 300, updated or modified versions of these files may be more easily transmitted to a Web browser.

As readily apparent from these teachings, the data object 314 is built using an executable script found in the datafile code 312, and the data object 314 is stored in memory.

Based upon the teachings within Durham, Applicants submit that Durham fails to teach or suggest distributing over a network to a content browser a graphical menu-structure. Instead, Durham teaches the information used to form the menu is found in the data object 314, and the data object 314 is stored in memory. Thus, the data object 314 is not distributed over a network to a content browser, since the data object 314 already resides in the same location as the browser. Moreover, the data object 314 does not correspond to the claimed "graphical menu-structure." The data object 314 is not "graphical," given the broadest reasonable claim

construction of the term "graphical." Instead, the data object 314 is just a collection of data about a menu.

Independent claims 9 and 10 include similar limitations, which are similarly not disclosed by Durham. The Examiner's secondary reference of Alexander does not cure these argued deficiencies of Durham. Thus, even if one having ordinary skill in the art were motivated to modify Durham in view of Alexander, the claimed invention would not result. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 1-4, 7, and 9-10 under 35 U.S.C. § 103 for obviousness based upon Durham in view of Alexander.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

Application No.: 10/041,136

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

/s/ Scott D. Paul

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

CUSTOMER NUMBER 46320